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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,193	01/21/2004	Kia Silverbrook	WAL14US	2176

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, NSW 2041  
AUSTRALIA

EXAMINER

COLILLA, DANIEL JAMES

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/760,193	<b>Applicant(s)</b> SILVERBROOK ET AL.	
	<b>Examiner</b> Daniel J. Colilla	<b>Art Unit</b> 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 19-30, 32-46 and 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 31 and 47 is/are rejected.
- 7) ☒ Claim(s) 2-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/21/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 31 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 31, line 1, applicant recites, “wherein utilizing an on-demand printer further comprises.” However, applicant has not previously recited any steps of utilizing an on-demand printer. Additionally, the steps recited in claim 31 appear to be largely a double recitation of the steps recited in claim 1, only with different terminology. Clarification and/or correction is required.

Claim 47 has similar problems. It appears that a large portion of the recited structure in claim 47 is a double recitation of structure recited in claim 1, only using different terminology.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 41 of U.S. Patent No. 6,944,970. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 41 of U.S. Patent No. 6,944,970 includes all the steps recited in claim 1 of the present invention.

5. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 43 of U.S. Patent No. 6,920,704. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 43 of U.S. Patent No. 6,920,704 includes all the steps recited in claim 1 of the present invention.

6. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 42 of copending Application No. 10/760,257. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 42 of copending Application No. 10/760,257 recites all the steps recited in claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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7. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 43 of copending Application No. 10/760,251.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 43 of copending Application No. 10/760,251 recites all the steps recited in claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 43 of copending Application No. 10/760,240.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 43 of copending Application No. 10/760,240 recites all the steps recited in claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 43 of copending Application No. 10/760,226.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 43 of copending Application No. 10/760,226 recites all the steps recited in claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 42 of copending Application No. 10/760,224.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 42 of copending Application No. 10/760,224 recites all the steps recited in claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 44 of copending Application No. 10/760,269.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 44 of copending Application No. 10/760,269 recites all the steps recited in claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 43 of copending Application No. 10/760,266.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 43 of copending Application No. 10/760,266 recites all the steps recited in claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 44 of copending Application No. 10/760,260.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 44 of copending Application No. 10/760,260 recites all the steps recited in claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 43 of copending Application No. 10/760,241.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 43 of copending Application No. 10/760,241 recites all the steps recited in claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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15. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 43 of copending Application No. 10/760,230.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 43 of copending Application No. 10/760,230 recites all the steps recited in claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 43 of copending Application No. 10/760,215.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 43 of copending Application No. 10/760,215 recites all the steps recited in claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 44 of copending Application No. 10/760,214.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 44 of copending Application No. 10/760,214 recites all the steps recited in claim 1 of the present application.



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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Allowable Subject Matter*

18. Claims 1-18 would be allowable if the double patenting rejections are overcome by filing terminal disclaimers as mentioned above.

19. Claims 31 and 47 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and if the double patenting rejections are overcome filing terminal disclaimers as mentioned above.

20. The following is a statement of reasons for the indication of allowable subject matter:

Claims 1-18, 31 and 47 have been indicated as containing allowable subject matter primarily for the steps of leading a free edge of the wallpaper media roll between a pair of rollers and past an edge of the open case and then with the rollers located within the case and on either side of the web, closing the case and loading it into a printer.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 5, 2006

A handwritten signature in black ink, appearing to read "Daniel J. Colilla". The signature is stylized with a large, looped initial "D" and a trailing flourish.

**Daniel J. Colilla**  
Primary Examiner  
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